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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR   | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|------------------------|---------------------|------------------|
| 10/698,193      | 10/30/2003  | Howard Shelton Lambert | GB920020090US1      | 3546             |

7590 05/04/2005  
IBM Corporation  
IP Law Department  
11400 Burnet Road  
Austin, TX 78758

EXAMINER

MASINICK, MICHAEL D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2125

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                       |  |
|------------------------------|--|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/698,193   | <b>Applicant(s)</b><br>LAMBERT ET AL. |  |
|                              | <b>Examiner</b><br>Michael D. Masinick | <b>Art Unit</b><br>2125               |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/30/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

8

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Boxes without labels and only numbers attached are not considered drawings. Drawings need to be updated at a minimum to label the boxes in the apparent flow charts. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

1. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The wording of this claim must conform to current U.S. Practice which dictates that computer programs must be embodied on a computer readable medium (not simply "able to be executed").

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

(A) For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences,

Art Unit: 2125

for example), and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the process must somehow apply, involve, use, or advance the technological arts.

In the present case, independent claims 1, 8, and 16 only recites an abstract idea. The recited steps of interrogating a first parameter, comparing it to a range, and changing another parameter based on the comparison does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps as claimed only constitute an idea of how to determine a problem with generic numbers.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention "adjusts a second parameter" but does not use that parameter or show how the parameter is adjusted. This could simply be a person scratching out one number on a piece of paper and writing another.

Since the claimed invention as a whole, is not within the technological arts as explained above, claims 1-28 are deemed to be directed to non-statutory subject matter.

In order to rectify this situation, changes must be made to the claims to clearly identify the steps as computer controlled and manipulated variables which produce a useful/tangible output.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2125

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No. 6,317,635 to Ochs et al.

3. Referring to claims 1, 8, 15, and 16 Ochs shows a system for controlling a first component comprising: means for interrogating a first parameter having an associated threshold (Figure 2 - 104); means for determining whether the first parameter meets the associated threshold (Column 1, lines 27-30); and means, responsive to a successful determination, for adjusting a second parameter for controlling the first component (Column 1, lines 50-53), wherein the first and second parameters are expressed as a logical expression and wherein each parameter comprises at least three values corresponding to a minimum value and a maximum value together representing a range and a variable value (Column 4, lines 52-63). Examiner notes that Ochs shows a multitude of ways to set threshold values using software for maximum and minimum values depending on the needs of the application.

4. Examiner notes that with regard to claim 16 specifically, all of these instances are shown in a medical environment with physiological parameters.

5. Referring to claims 2, 9, and 17, Ochs shows means for initializing each parameter, wherein upon initialization, the variable value represents an initial value (ABSTRACT – “In an embodiment of the electrotherapy apparatus, the energy source includes a high voltage power supply for charging a capacitor to a selected one of a plurality of initial voltages.”).

Art Unit: 2125

6. Referring to claims 3, 10, and 18, Ochs shows wherein upon interrogation, the variable value represents a current value (Column 4, line 24). Examiner also notes that this could be taken to mean "current" as in "present time" value which Ochs also shows.

7. Referring to claims 4, 11, and 19, Ochs shows means, responsive to the current value of the first parameter lying outside of the range, for executing an action (Column 1, lines 50-53).

8. Referring to claims 5, 12, and 20, Ochs shows means for adjusting adjusts the current value of the second parameter (Column 4, lines 28-64).

9. Referring to claims 6, 13, and 21, Ochs shows means for initialising is executed by an application program (Controller 38 – "program control").

10. Referring to claims 7, 14, and 22, Ochs shows a network and a second component, wherein the second parameter controls the first and second components (See top of column 5). Examiner notes that Ochs shows multiple ways of using the measured parameters to control various outputs which affect various machines and voltages for the patient. The term "network" is not understood in the current context because there are no computers claimed.

### *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2125

12. Claims 23-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S Patent No. 6,317,635 to Ochs et al in view of U.S. Patent No 4,437,859 to Whitehouse et al.

13. Ochs does not show the specific medical components as set forth in claims 23-28.

14. Whitehouse shows a self-contained hydraulic drive device for continuously and automatically actuating a hypodermic syringe for administering fluid medicinal compositions to a patient's body. Whitehouse shows a syringe driver, the use of blood sugar levels in determining the amount of medicine to administer, a sugar solution/insulin level and heart rate.

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the syringe of Whitehouse and the knowledge of blood sugar levels and insulin as are well known in the art in combination with the sensor medical devices of Ochs in order to monitor patients because maintaining a normal blood glucose level greatly reduces the risk of experiencing complications due to diabetes. Whether an individual has type 1 or type 2 diabetes, regular use of a glucose (sugar) monitor to determine blood sugar levels will help determine what adjustments to diet, oral medications, or insulin injections may be necessary to achieve good control.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael D. Masinick whose telephone number is (571) 272-3746. The examiner can normally be reached on Mon-Fri, 7:30-4:00.

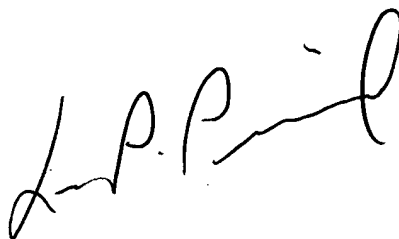


Art Unit: 2125

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MDM

A handwritten signature in black ink, appearing to read 'L. Picard', is written over the printed name and title.

LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100